



UNITED STATES PATENT AND

TRADEMARK OFFICE



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OFFICE OF PETITIONS

In re Application of :
Tchernev, Spytek, Zerhusen, :
Patturajan, Shimkets, Li, Gangolli, : DECISION REFUSING STATUS
Padigaru, Anderson, Rastelli, : UNDER 37 CFR 1.47(a)
Miller, Gerlach, Taupier, Gusev, :
Colman, Wolenc, Pena, Furtak, :
Grosse, Alsobrook, Lepley, Rieger, :
and Burgess :
Application No. 10/072,012 :
Filed: 31 January, 2002 :
Atty Dcket No. 21402-258 (X) Cura 558) :

This is in response to the petition filed under 37 CFR 1.47(a) on 13 December, 2002.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 31 January, 2002, without an executed oath or declaration. Accordingly, on 13 May, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application requiring an executed oath or declaration and a surcharge for its late filing as well as a Computer Readable Form of the "Sequence Listing" in

compliance with 37 CFR 1.821-1.825. A two (2) month period for reply was set. In response, on 13 December, 2002, the present petition was filed, along with a five (5) month extension of time and a declaration naming Velizar Tchernev, Kimberly Spytek, Bryan Kerhusen, Meera Paturajan, Richard Shimkets, Li Li, Esha Gangolli, Muralidhara Padigaru, David W. Anderson, Luca Rastelli, Charles E. Miller, Valerie Gerlach, Raymond J. Taupier, Jr., Vladimir Y. Gusev, Steven D. Colman, Adam Ryan Wolenc, Carol E.A. Pena, Katarzyna Furtak, William M. Grosse, John P. Alsobrook II, Denise M. Lepley, Daniel K. Riger, and Catherine E. Burgess as joint inventors and signed by all joint inventors except Lepley on behalf of themselves and joint inventor Lepley.

Petitioners assert that a copy of the declaration and assignment were sent to joint inventor Lepley, but she refused orally to sign and return the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In respect to item (1), petitioners must provide proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent or given to each non-signing inventor at his or her last known address for review.¹ Petitioners may provide proof by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a bona fide refusal to sign can be alleged

¹MPEP 409.03(d).

petitioners must show that a copy of the application papers (specification, including claims, drawings, if any, and the declaration) were sent or given to each non-signing inventor. If there is a written refusal, petitioners must provide a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

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Office of Petitions